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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/296,276	04/22/99	SCHUMACHER	<sup>mk</sup> 225/47721

IM22/0621  
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WASHINGTON DC 20005

EXAMINER
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LEE, E

ART UNIT	PAPER NUMBER
1732	6

DATE MAILED: 06/21/00

Please find below and/or attached an Office communication concerning this application r proceeding.

Commissioner of Patents and Trademarks

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# Office Action Summary

Application No.  
09/296,276

Applicant(s)

SCHUMACHER

Examiner

EDMUND LEE

Group Art Unit  
1732



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-26 is/are pending in the application.

Of the above, claim(s) 12-26 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-11 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been  
☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### **DETAILED ACTION**

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-11, drawn to a process for manufacturing a covering, classified in class 264, subclass 135.
  - II. Claims 12-24, drawn to a covering, classified in class 428, subclass 31.
  - III. Claims 25-26, drawn to an apparatus, classified in class 425, subclass 542.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can be made by another and materially different process such as laminating, stamping, sheeting, or welding.

3. Inventions I and III are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process such as metal sheet.

4. Inventions III and II are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as

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claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product as claimed can be made by another and materially different apparatus such as laminating press or compression mold

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Donald Evenson on 5/26/00 a provisional election was made with oral traverse to prosecute the invention of I, claims 1-11. Affirmation of this election must be made by applicant in replying to this Office action. Claims 12-26 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

7. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the *elected* claims are directed.

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1 and 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Masui et al (USPN 5223201). Masui et al teach the claimed process including manufacturing a covering or

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trim part with directly molded-on carrier (figs 3-11); placing a decor part into an at least two-part injection mold (figs 3-11); closing the mold, thereby cutting the decor part to precise contours in the injection mold (figs 3-11); pressing the decor part by injecting a molding compound against a surface of the decor part opposite at least one injection opening (figs 3-11); connecting the injection molding compound with the decor part during hardening of the molding compound (figs 3-11); and opening the injection mold and removing the covering or trim part and molded-on carrier (figs 3-11). Masui et al also teach simultaneously cutting and stamping the decor part.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 2-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5223201). The above teachings of Masui et al are incorporated hereinafter. Masui et al does not teach the specific injection molding temperature and the specific mold temperature. In regard to the specific injection molding temperature, molding temperature is well-known in the molding art as important molding parameters which is dependent on the molding material, preform material, and equipment. Further, the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Furthermore, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the

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invention was made to injection mold at the claimed temperature in order to effectively connect the decor part to the molding compound. In regard to the specific mold temperature, mold temperature is well-known in the molding art as important molding parameters and the desired temperature would have been obviously and readily determined through routine experimentation by one having ordinary skill in the art at the time the invention was made. Further, the claimed temperature is generally well-known in the molding art and it would have been obvious to one of ordinary skill in the art at the time the invention was made to set the injection mold of Masui et al at the claimed temperature in order to effectively mold a high quality injection molded covering or trim part.

12. Claims 4-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5223201) in view of Kato et al (USPN 5225264). The above teachings of Masui et al are incorporated hereinafter. Masui et al does not teach using a veneer wood layer; placing a nonwoven coating saturated with phenol melamine resin and a layer of glue on the veneer wood layer; placing a layer of glue on the veneer wood layer; and placing a layer of blind veneer on the veneer wood layer. Kato et al teach injection molding a covering or trim part having a decor part comprised of wood veneer glued to a metal sheet which glued to another wood veneer (blind veneer) (figs 1-9). Masui et al and Kato et al are combinable because they are analogous with respect to molding an interior part of an automobile. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute a sheet of the decor part of Kato et al for the decor part of Masui et al in order to form an automobile covering or trim part

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having a wood veneer appearance. In regard to placing a nonwoven coating saturated with phenol melamine resin on the veneer wood layer, such is well-known in the molding art as a substitutable alternative for a metal layer. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the claimed nonwoven coating for the metal layer of Masui et al (modified) in order to reduce cost and further diversify the covering or trim part of Masui et al.

13. Claims 8-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5223201) in view of Conner (USPN 4369157). The above teachings of Masui et al are incorporated hereinafter. Masui et al does not teach using a decor part comprised of a sheet metal part; applying a coupling layer to the backside of the sheet metal part; and heating or activating the coupling layer with the injection molding compound. Conner teaches injection molding a covering having a decor part comprised of a sheet metal part with a coupling layer (adhesive layer) attached to a backside thereof; heating or activating the coupling layer with the injection molding material (col 5, lns 38-41; col 10, lns 1-35); using a reactive hot melt type adhesive or dry glue film (col 10, lns 1-35). Masui et al and Conner are combinable because they are analogous with respect to injection molding against a sheet preform to create a decorative article that has utility in an automobile. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the decor part of Conner for the decor part of Masui et al in order to further diversify the covering or trim part of Masui et al.

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14. Claim 10 <sup>is</sup> ~~are~~ rejected under 35 U.S.C. 103(a) as being unpatentable over Masui et al (USPN 5223201) in view of Stickling (USPN 5525179). The above teachings of Masui et al are incorporated hereinafter. Masui et al does not teach embedding fastening elements in the injection molding compound. Stickling teaches injection molding a covering or trim part having embedded fastening elements therein (figs 5-7). Masui et al and Stickling are combinable because they are analogous with respect to injection molding covering or trim parts. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to embed fastening elements as taught by Stickling in the injection molding compound of Masui et al in order to securely attach fastening elements to the covering of Masui et al.

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Harada et al (USPN 5830402) teaches simultaneously injection molding a covering and cutting a decor part. Munger et al (USPN 5902533) teach injection molding a fastening element to a covering or trim part.

16. Any inquiry concerning this communication or earlier communication from the examiner should be directed to Edmund Lee whose telephone number is (703)305-4019. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan H. Silbaugh, can be reached on (703)308-3829. The fax phone number for this Group is (703)305-7718.

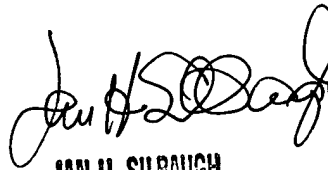


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703)308-0661.

EHL

June 19, 2000

  
JAN H. SILBAUGH  
SUPERVISORY PATENT EXAMINER  
ART UNIT 1732

06/19/00